UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,474	03/29/2001	Takumi Tanabe	8861-400US (P23811-01)	5649

570 7590 08/04/2005	EXAMINER
AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103	FISH, JAMIESON W

ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/820,474	TANABE ET AL.
	Examiner	Art Unit	
	Jamieson W. Fish	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>31 May 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-12</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-12</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>31 May 2005</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 05-31-2005 has being

considered by the examiner.

Drawings

The drawings were received on 05-31-2005. These drawings are acceptable.

Response to Arguments

Applicant's arguments filed 5-31-2005 have been fully considered but they are

not persuasive. The applicant argues that the added claim language of "and also

instructing how said contents should be reproduced in accordance with the way the

advertising information is reproduced" renders independent claims 1, 2, 3, 7 and 9

allowable over the prior art rejections of record (See Remarks Pg 12 Paragraph 2, Pg

13 Paragraph 13). The examiner respectfully disagrees. Wu teaches where advertising

scenario header also instructs how said contents should be reproduced in accordance

with the way the advertising information is reproduced (See Fig. 10 Step 266 and Col. 5

lines 23-40, Col. 7 lines 55-67, Col. 8 lines 1-8, Col. 12 lines 48-51). The mapping

information (advertising scenario header) comprises layout parameters. The layout

parameters are instructions to the system indicating how web pages and the program

schedule segment (contents) will be displayed. Overlaying an advertisement web page

over the program image (PIP mode), changing how much of the area of the screen the

program image occupies (changing from full-screen to split screen), and not displaying

the program when the web page is displayed (toggle mode) are all ways of controlling

how said contents are reproduced in accordance with the way the advertising information is reproduced.

The applicant also argues that the combination of Wu and Dunn is improper (See Remarks Pg 14 Paragraph 2). The examiner respectfully disagrees. The applicant argues that Wu specifically teaches away from such a combination because Wu is specifically designed to concurrently display and not interrupt the ongoing video content as well as information from a web site (See Remarks Pg. 14 Paragraph 2). Wu teaches where mapping information indicates how advertising web pages are to be displayed in accordance with programs (See Fig. 10 Step 266 and Col. 5 lines 23-40, Col. 7 lines 55-67, Col. 8 lines 1-8, Col. 12 lines 48-51). One of the modes for display is where the user can toggle back and forth between the display of the web page and the program (See Col. 5 lines 23-56). Such a toggling interrupts the display of the ongoing video content, since the video content is not displayed when the web page is displayed. When the web page is displayed the transmission of the program is not necessarily stopped. Since the program is transmission of the program is not necessarily stopped, the user may miss segments of the program while viewing web content. Thus, there is clear motivation to combine Wu with Dunn to stop the transmission of the program when the user toggles to the web content, so the user does not miss program segments. Although, the applicant argues that present invention is directed towards control of content without operation of the viewer, features upon which applicant relies (i.e., not operation by the viewer, the user has no control, See Remarks Pg. 14 Paragraph 3) are not recited in the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re*

Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can

be found in a prior Office action.

1.   Claims **2** and **8** are rejected under 35 U.S.C. 102(e) as being anticipated by Wu

et al (US 6,326,982).

2.   Regarding claim **2**, Wu teaches a broadcast system comprising a broadcast

station and a television broadcast receiver connected to said broadcast station by a

two-way channel (See Fig. 1 Web/TV Client System 12, Video Data Provider 16,

Dedicated Server Providing TV Programming Schedule/Web Address Mapping

information 34 and Col. 4 lines 3-39, Col. 5 lines 5-22. A cable network is a two-way

channel. Video Data Provider (16) and Internet (22) can both be connected to Web/TV

(12) through a cable network, therefore the Video Data Provider and the Server (34) are

equivalent to a broadcast station), wherein said television broadcast receiver comprises

a browser unit for reproducing display data coded by the Hyper Text Markup Languages

(See Fig. 2 Processor 56 and Video Processor 92 and Col.4 lines 18-39 and Col. 5 lines

5-55 Processor and Video Processor display HTML coded data) and an Internet access

unit for accessing the Internet to obtain display data coded by the Hyper Text Markup

Language (See Fig. 2 Processor 56, Internet Unit 68 and Col. 4 lines 18-39 Col. 5 line

5-55. Processor and Internet Unit access Internet) and wherein said broadcast station

transmits, prior to or during the transmission of contents an advertising scenario header

for at least instructing what kind of advertising information should be reproduced and in

what way (See Fig. 10 Steps 256 and 258 Col. 4 lines 18-39, Col. 6 lines 19-27, Col. 8

lines 9-43, Col. 11 lines 18-67, and Col. 12 lines 1-60. Programming schedule mapping

information is downloaded to the receiver. Information tells the receiver which web

pages to access during content transmission. Web pages can include advertisement

information. Therefore, programming schedule mapping information is equivalent to

advertising scenario header), and also instructing how said contents should be

reproduced in accordance with the way the advertising information is reproduced (See

Fig. 10 Step 266 and Col. 5 lines 23-40, Col. 7 lines 55-67, Col. 8 lines 1-8, Col. 12 lines

48-51), and during the reception and reproduction of said contents said television

broadcast receiver accesses said display data on the Internet by means of said Internet

access unit and reproduces information, obtained by accessing said display data, and

said advertising information by means of said browser unit in accordance with the

contents of said advertising scenario header received from said broadcast station. (See

Fig. 10 Step 256 and 258 Col. 4 lines 18-39, Col. 6 lines 19-27, Col. 8 lines 9-31, Col.

11 lines 18-67, and Col. 12 lines 1-60).

3.   Regarding claim **8**, it is a method claim corresponding to the apparatus claim **2**.

Therefore, claim **8** is analyzed and rejected according to claim **2**.

Claim Rejections - 35 USC § 103

4.   Claims **1, 3-4, 6-7, 9-10**, and **12** are rejected under 35 U.S.C. 103(a) as being

unpatentable over Wu et al. in view of Broadwin et al (US 5,903,816).

5.   Regarding claim **1**, Wu teaches a broadcast system comprising a broadcast

·station and a television broadcast receiver connected to said broadcast station by a

two-way channel (See Fig. 1 Web/TV Client System 12, Video Data Provider 16,

Dedicated Server Providing TV Programming Schedule/Web Address Mapping

information 34 and Col. 4 lines 3-39, Col. 5 lines 5-22. A cable network is a two-way

channel. Video Data Provider and Internet can both be connected to Web/TV through a

cable network therefore the Video Data Provider and the Server are equivalent to a

broadcast station), wherein said television broadcast receiver comprises a browser unit

for reproducing display data coded by the Hyper Text Markup Language (See Fig. 2

Processor 56 and Video Processor 92 and Col.4 lines 18-39 and Col. 5 lines 5-55

Processor and Video Processor display HTML coded data), and a storage unit (See Fig.

2 Memory Unit 76 Col. 4 lines 40-56) and wherein said broadcast station transmits prior

to or during the transmission of contents an advertising scenario header for at least

instructing what kind of advertising information should be reproduced and in what way

(See Fig. 10 Steps 256 and 258 Col. 4 lines 18-39, Col. 6 lines 19-27, Col. 8 lines 9-43,

Col. 11 lines 18-67, and Col. 12 lines 1-60. Programming schedule mapping information

is downloaded to the receiver. Information tells the receiver which web pages to access

during content transmission. Web pages can include advertisement information.

Therefore, programming schedule mapping information is equivalent to advertising

scenario header), and also instructing how said contents should be reproduced in

accordance with the way the advertising information is reproduced (See Fig. 10 Step

266 and Col. 5 lines 23-40, Col. 7 lines 55-67, Col. 8 lines 1-8, Col. 12 lines 48-51), and

during the reception and reproduction of said contents said television broadcast receiver

reproduces said advertising information by means of said browser unit in accordance

with the contents of said advertising scenario header received from said broadcast

station (See Fig. 10 Steps 256 and 258 Col. 4 lines 18-39, Col. 6 lines 19-27, Col. 8

lines 9-31, Col. 11 lines 18-67, and Col. 12 lines 1-60). Wu fails to disclose where

HTML advertisement is stored in the memory and the browser unit reproduces

advertisement information stored in memory. Having a television receiver store

interactive programming data in memory for reproduction during the transmission of

content is well known in the art as taught by Broadwin (See Fig. 8 Step 444, Abstract

and Col. 11 lines 37-62). Therefore, it would have been obvious to one of ordinary skill

in the art at the time the invention was made to modify Wu's invention so that the

receiver stored advertisement information in memory and the browser unit reproduced

advertisement information from memory as taught by Broadwin so that advertisement

information could be provided more quickly, thus reducing latency and providing greater

responsiveness (See Broadwin Col. 3 lines 12-16).

6.   Regarding claim **3**, Wu teaches a broadcast system comprising a broadcast

station and a television broadcast receiver connected to said broadcast station by a

two-way channel (See Fig. 1 Web/TV Client System 12, Video Data Provider 16,

Dedicated Server Providing TV Programming Schedule/Web Address Mapping

information 34 and Col. 4 lines 3-39, Col. 5 lines 5-22. A cable network is a two-way

channel. Video Data Provider and Internet can both be connected to Web/TV through a

cable network therefore the Video Data Provider and the Server are equivalent to a

broadcast station), wherein said television broadcast receiver comprises a browser unit

for reproducing display data coded by the Hyper Text Markup Language (See Fig. 2

Processor 56 and Video Processor 92 and Col.4 lines 18-39 and Col. 5 lines 5-55

Processor and Video Processor display HTML coded data), a storage unit (See Fig. 2

Memory Unit 76 Col. 4 lines 40-56), and an Internet access unit for accessing the

Internet to obtain display data coded by the Hyper Text Markup Language (See Fig. 2

Processor 56, Internet Unit 68 and Col. 4 lines 18-39 Col. 5 line 5-15. Processor and

Internet Unit access Internet) and wherein said broadcast station transmits, prior to or

during the transmission of contents an advertising scenario header for at least

instructing what kind of advertising information should be reproduced and in what way

(See Fig. 10 Steps 256 and 258 Col. 4 lines 18-39, Col. 6 lines 19-27, Col. 8 lines 9-43,

Col. 11 lines 18-67, and Col. 12 lines 1-60. Programming schedule mapping information

is downloaded to the receiver. Information tells the receiver which web pages to access

during content transmission. Web pages can include advertisement information.

Therefore, programming schedule mapping information is equivalent to advertising

scenario header), and also instructing how said contents should be reproduced in

accordance with the way the advertising information is reproduced (See Fig. 10 Step

266 and Col. 5 lines 23-40, Col. 7 lines 55-67, Col. 8 lines 1-8, Col. 12 lines 48-51), and

during the reception and reproduction of said contents said television broadcast receiver

accesses said display data on the Internet by means of said Internet access unit and

reproduces information, obtained by accessing said display data, and said advertising

information by means of said browser unit in accordance with the contents of said

advertising scenario header received from said broadcast station (See Fig. 10 Steps

256 and 258 Col. 4 lines 18-39, Col. 6 lines 19-27, Col. 8 lines 9-31, Col. 11 lines 18-67,

and Col. 12 lines 1-60). Wu differs from the claimed invention in that his browser unit

does not necessarily reproduce advertisement information stored in memory. Having a

television receiver store interactive programming data in memory for reproduction

during the transmission of content is well known in the art as taught by Broadwin (See

Fig. 8 Step 444, Abstract and Col. 11 lines 37-62). Therefore, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify

Wu's invention so that the receiver stored advertisement information in memory and the

browser unit reproduced advertisement information from memory as taught by Broadwin

so that advertisement information could be provided more quickly, thus reducing latency

and providing greater responsiveness (See Broadwin Col. 3 lines 12-16).

7.   Regarding claim **4**, Wu as modified by Broadwin teaches wherein said television

broadcast receiver comprises an input unit for inputting data (See Wu Fig. 2 Remote

Control 52 and Col. 4 lines 40-44), said advertising information includes input instruction

of limiting information for reproducing a description instructing to input limiting

information using said input unit (See Wu Col. 6 lines 15-43, User inputs limiting

preferences via electronic fill-in form provided by server), said advertising scenario

header includes information for instructing to resume the reproduction of said contents

or said advertising information after data has been inputted using said input unit in

response to said reproduced input instruction of limiting information (See Wu Fig. 10

Steps 270, 272, Col. 6 lines 15-43, Col. 12 lines 61-67 and Col 13 lines 1-3. The user

uses input device and browser to limit preferences via an electronic fill-in form provided

by server. The mapping information includes instructions to provide user with new

personalized web pages after the user completes the electronic fill-in form. This is

resuming the reproduction of advertising content) and also includes information for

instructing in accordance with the contents of said limiting information what kind of

advertising information should be reproduced (See Wu Col. 6 lines 15-43), and said

television broadcast receiver reproduces said advertising information during the

reception and reproduction of said contents in accordance with the contents of said

advertising scenario header and said limiting information inputted from said input unit

(See Wu Col. 6 15-43).

8.   Regarding claim **6**, Wu as modified by Broadwin teaches wherein a data

gathering unit for receiving data from said television broadcast receiver and for storing

said data is provided at least either in said broadcast station or on the internet (See Wu

Fig. 1 Dedicated Server 34, Fig. 3 and Col. 5 lines 63-67 and Col. 6 lines 1-14

Dedicated server is data gathering unit), said television broadcast receiver comprises a

data input unit for inputting data (See Wu Fig. 2 Remote Control 52 and Col. 4 lines 40-

44), and a data transmitting unit for transmitting said data to said data gathering unit

(See Wu Fig. 2 Internet Unit 68 Col. 5 lines 5-23), said advertising information includes

data input instruction information for reproducing a description instructing to input data

using said input unit (See Wu Col. 6 lines 15-43, User inputs limiting preferences via

electronic fill-in form provided by server), said advertising scenario header includes

information for instructing to resume the reproduction of said contents or said

advertising information after said data has been inputted using said input unit in

response to said reproduced data input instruction information (See Wu Fig. 10 Step

270, 272, Col. 6 lines 15-43, Col. 12 lines 61-67 and Col 13 lines 1-3. The user uses

input device and browser to limit preferences via an electronic fill-in form provided by

server. The mapping information includes instructions to provide user with new

personalized web pages after the user completes the electronic fill-in form. This is

resuming the reproduction of advertising content), and said television broadcast

receiver transmits the contents of said data inputted from said input unit, to said data

gathering unit by means of said data transmitting unit (See Wu Col. 6 lines 23-26 fill-in

order form).

9.   Regarding claims **7, 9-10,** and **12** they are method claims corresponding to the

apparatus claims **1, 3-4,** and **6** respectively. Therefore, claims **7, 9-10,** and **12** are

analyzed and rejected according to claims **1, 3-4,** and **6**.

10.   Claims **5** and **11** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Wu et al. in view of Broadwin and further in view of Dunn et al. (US 5,517,257).

11.   Regarding claim **5,** Wu as modified with Broadwin teaches wherein said

television broadcast receiver comprises a reproduction control unit for controlling the

reproduction of said contents (See Wu Col. 5 lines 44-47 Toggling between a web

browser and TV viewing is controlling reproduction). Wu and Broadwin differs from the

claimed invention in that the television broadcast receiver does not instruct the

broadcast station through said reproduction control unit to temporarily stop the

transmission of said contents when starting the reproduction of said advertising

information during the reception and reproduction of said contents, and instructs said

broadcast station through said reproduction control unit to restart the transmission of

said contents when ending the reproduction of said advertising information. However, a

receiver with a control unit that can instruct a broadcast station to temporarily stop and

resume the transmission a contents is well know in the art as taught by Dunn (See Col.

7 lines 63-67 and Col. 8 lines 1-31). Therefore, it would have been obvious to one of

ordinary skill in the art to further modify Wu and Broadwin's reproduction control unit so

that it gave the user the ability to temporarily stop the transmission of content when

accessing advertisement information and the ability to resume transmission of content

as taught by Dunn in order to assist the viewer in controlling the viewing of the contents

transmitted from the server (See Dunn Col. 1 lines 55-56).

12.   Regarding claim **11**, it is a method claims corresponding to the apparatus claim

5. Therefore, claims **11** is analyzed and rejected according to claims **5**.

<div align="center">

Conclusion

</div>

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamieson W. Fish whose telephone number is 571-272-7307. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Ngoc Vu can be reached on 571-272-7320. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JF 7/26/2005

NGOC-YEN VU
PRIMARY EXAMINER